

## **REMARKS/ARGUMENTS**

### **Status of the Claims**

Claims 1-12, 14, 17-20 and 23-25 are currently pending in the application. Claims 1, 7, 10, 12, 14 and 17 have been amended. No claims have been added or cancelled. Therefore, claims 1-12, 14, 17-20 and 23-25 are present for examination. Claims 1, 10, 17 are independent claims.

Prior to entry of this amendment, the application included claims 1-12, 14, 17-20 and 23-25. In the final Office Action mailed December 5, 2008, claims 1, 3-4, 6, 8-11, 17-20, 23 and 24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0160780 A1 issued to Mukerjee et al. (“**Mukerjee**”) in view of U.S. Patent Application Publication No. 2003/0095569 issued to Wengrovitz et al. (“**Wengrovitz**”). Claims 12, 14 and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Mukerjee in view of Wengrovitz, and further in view of U.S. Patent No. 6,816,582 issued to Levine et al. (“**Levine**”). Claim 2 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Mukerjee in view of Wengrovitz, and further in view of U.S. Patent No. 7,162,020 issued to Forte (“**Forte**”). Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Mukerjee in view of Wengrovitz, and further in view of U.S. Patent Application Publication No. 2004/0170268 issued to Hokusui (“**Hokusui**”). Claims 1-4, 8-12, 14, 17-21 and 23-25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Forte in view of Wengrovitz, and further in view of Levine. Claims 5-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Forte in view of Wengrovitz, and further in view of Hokusui.

### **Claim Rejections Under 35 U.S.C. 103**

Claims 1, 3-4, 6, 8-11, 17-20, 23 and 24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Mukerjee in view of Wengrovitz. Applicants respectfully request reconsideration of the rejection because either the Examiner has failed to show a *prima*

*facie* case of anticipation or the amendments overcome the rejection. To establish a *prima facie* case of obviousness, all claim limitations must first be taught or suggested by the prior art. *See, e.g., DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (*citing In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). The Examiner must then provide an explicit analysis supporting the rejection. *See KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (“a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”). While the Examiner can choose one of several exemplary rationales from the MPEP to support an obviousness rejection under *KSR*, all the rationales still require the Examiner to demonstrate that all the claim elements are shown in the prior art. *See* MPEP § 2143, Original Eighth Edition, August 2001, Latest Revision July 2008.

Claim 1:

**Missing Limitation: “a demarcation device coupled to the first, second, and third communication channels”**

Claim 1 requires “a demarcation device coupled to the first, second, and third communication channels.” The Examiner states that Mukerjee shows a demarcation device interposed between the first and second communication channels and the one or more wired phones. *See Office Action*, p. 5. The Examiner further explains that Wengrovitz shows a SIP adapter interposed between the third communication channel and the one or more wired phones. *See Office Action*, pp. 9-10. However, the Examiner has not shown a single device coupled to all of the first, second, and third communication channels. Rather, the Examiner has shown a first device coupled to two channels and a second device coupled to a third device. This is different than the present claim, which requires one device coupled to all three channels. For at least this reason, claim 1 is allowable over the cited art.

**Missing Limitation: “the demarcation device interposed between the third communication channel and the wired phones, and wherein the demarcation device is interposed between the Internet and the one or more SIP phones”**

Claim 1 requires “the demarcation device interposed between the third communication channel and the wired phones, and wherein the demarcation device is interposed between the Internet and the one or more SIP phones.” The Examiner states that Wengrovitz shows a SIP adapter interposed between the third communication channel and the one or more wired phones. *See Office Action*, pp. 9-10. However, the Examiner has not shown the SIP adapter interposed between the Internet and the SIP phones. Indeed, Wengrovitz shows that the SIP agent and the “IP Network” (which the Examiner has dubiously equated to the Internet without any supporting reference) are in direct communication. *See Wengrovitz*, ¶ [0029] and Figs. 1-6 and 8. Thus, the system of Wengrovitz is different than the present claim, which requires one device interposed between the Internet and the SIP phones. For at least this reason, claim 1 is allowable over the cited art.

**Missing Limitation: “the demarcation device determines if the first, second, and third communication channels should be simultaneously sent the incoming phone call directed to the telephone number”**

Claim 1 requires “the demarcation device determines if the first, second, and third communication channels should be simultaneously sent the incoming phone call directed to the telephone number.” The Examiner has not stated a section of any reference that determines if a third communication channel should simultaneously receive the incoming call. The Examiner has stated that Mukerjee does show determination to send a call over two communication channels. *See Office Action*, p. 6. However, this argument does not equate to a single device determining if the call should be sent over three communication links. For at least this reason, claim 1 is allowable over the cited art.

**Motivation to Combine**

The Supreme Court in *KSR* specifically stated that obviousness is shown only if “the subject matter *as a whole* would have been obvious at the time the invention was made.” *KSR*, 127 S. Ct. at 1734 (*emphasis added*). In other words, the Examiner must provide a motivation to combine all references together. Applicants believe that it is improper to combine Mukerjee with Wengrovitz. Mukerjee teaches ringing wired and mobile phones. *See Mukerjee, Abstract*. Wengrovitz teaches an add-on feature to connect a PBX to a SIP agent. *See Wengrovitz, Abstract*. The Examiner is trying to teach a single device for communicating amongst several different devices with the combination of Mukerjee and Wengrovitz. Indeed, the Examiner has stated that the combination is “the demarcation device that now includes the SIP adapter module.” *See Office Action*, p. 10. Is the Examiner stating that there are now two devices? If so, this combination is in contradiction with the plain meaning of the claims. If, however, the Examiner is attempting to state that the SIP adapter of Wengrovitz is incorporated into the demarcation device of Mukerjee, the references specifically teach against this combination. Indeed, the Examiner specifically states that the motivation would be to “integrate the SIP network and the SIP phones with the network interface system of Mukerjee *without modifying the legacy system . . .*” Wengrovitz specifically states:

With the advent of Session Initiation Protocol (SIP), a powerful signaling protocol for creating, modifying, and terminating multimedia sessions, including Internet telephone calls between one or more SIP-endpoints, *many legacy PBX users want to migrate portions of the SIP technology into their existing infrastructure so that they can (1) retain all of their existing functionality, (2) take advantage of the many services SIP provides and (3) avoid the cost of purchasing a new IP-PBX system and its associated equipment (e.g., user sets) that already (or can as an option) internally incorporate the SIP technology*. Details about the SIP signaling protocol are set forth in Internet Engineering Task Force Request for Comment 2543 entitled “SIP: Session Initiation Protocol,” March 1999 (hereinafter referred to as RFC 2543), which is incorporated herein by reference, SIP provides an alternative to PBX- or H.323-signaled telephony.

*Wengrovitz*, ¶ [0004]

Wengrovitz does not motivate a person to change another device to incorporate communications with SIP devices. Actually, Wengrovitz teaches a person of skill in the art to add on the device externally to the system (thus creating two devices). Indeed, Wengrovitz's motivation of the invention states: "Accordingly, there is a need for a hybrid system that externally integrates a PBX system with a SIP network." *Wengrovitz*, ¶ [0005]. Wengrovitz very clearly teaches away from a combination as described by the Examiner.

Wengrovitz uses an add-on device to communicate with SIP agents. "The present invention provides for an adapter, referred to as a SIP Adapter Module (SAM) that couples a PBX system to a SIP network." *See Wengrovitz*, ¶ [0006]. To combine references, any changes to the systems or methods described in the systems must not make the references unsatisfactory for its intended purpose. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. § 2143.01 (*citing In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Modifying Wengrovitz from "an adapter coupled to the communications interface," to be included into the device of Mukerjee is contrary to the stated purpose of Wengrovitz – "a hybrid system that externally integrates a PBX system with a SIP network . . ." *Wengrovitz*, ¶ [0005]. As such, the Examiner's motivation is improper.

Claims 2-9:

Claims 2-9 each depend, either directly or indirectly, from allowable independent claim 1. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." M.P.E.P. § 2143.02 (*citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Therefore, claims 2-9 are also allowable over the cited art due, at least in part, to this dependence on an allowable base claim.

Claim 10:

Claim 10 includes the same or similar limitations to allowable claim 1. Thus, claim 10 is allowable over the cited art for the same or similar reasons.

Claims 11-12 and 14-15:

Claims 11-12 and 14-15 each depend, either directly or indirectly, from allowable independent claim 10. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” M.P.E.P. § 2143.02 (*citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Therefore, claims 11-12 and 14-15 are also allowable over the cited art due, at least in part, to this dependence on an allowable base claim.

Claim 17:

Claim 17 includes the same or similar limitations to allowable claim 1. Thus, claim 17 is allowable over the cited art for the same or similar reasons.

Claims 18-20 and 23-25:

Claims 18-20 and 23-25 each depend, either directly or indirectly, from allowable independent claim 17. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” M.P.E.P. § 2143.02 (*citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Therefore, claims 18-20 and 23-25 are also allowable over the cited art due, at least in part, to this dependence on an allowable base claim.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Applicants do not acquiesce to any objection, rejection, or argument not specifically addressed herein. Rather, the Applicants believe the amendments and arguments contained herein overcome all objections, rejections, or arguments.

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PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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